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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,686	01/24/2001	William B. Busa	16585.6.2	3892
22913	7590	03/02/2007		
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			EXAMINER ZHOU, SHUBO	
			ART UNIT 1631	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/02/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/768,686		BUSA, WILLIAM B.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Shubo (Joe) Zhou		1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/6/06, 8/9/04, and 6/24/04.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-27 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/23/01, 4/17/02</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Applicant's amendments and request for reconsideration filed 12/06/06, 8/9/04 and 6/24/04 are acknowledged. The amendment to the specification filed 6/24/04 and the amendment to the claims filed 12/6/06 have been entered and are based upon in the present action.

Claims 22-27 are currently pending and under consideration.

### ***Withdrawn Rejections***

The rejection of claims 21-22 and 24-27 under 35 U.S.C. 102(b) as being anticipated by Blaschke et al. set forth in the previous Office action is hereby withdrawn in view of applicant's amendment to the claims filed 12/6/06.

### ***Specification***

The specification is objected to because of the following:

The disclosure is objected to because it contains an embedded hyperlink and/or other form or browser-executable code. Such code is present in the specification at page 6, and/or elsewhere. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP ' 608.01.

This objection is reiterated from the previous Office action mailed 12/19/03. Applicant's arguments filed 6/24/04 have been fully considered but they are not persuasive. Applicant argues that the codes in the specification does not meet the definition for hyperlinks in the MPEP, which

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"describes such hyperlinks and other forms of browser-executable code by example as being 'a URL placed between these symbols < > and http:// followed by a URL address'." This is not found persuasive because as admitted by applicant, the definition of 'a URL placed between these symbols < > and http:// followed by a URL address' is only an example. What is critical is whether a code is browser-executable. In the instant case, the code www.proteome.com is browser-executable and thus needs to be deleted. As a matter of fact, while the examiner was preparing this Office action, he clicked the above code, and it lead him to the website with an URL of http://www.biobase-international.com/pages/.

Appropriate correction is required.

#### ***Information Disclosure Statements***

It was pointed out in the previous Office action mailed 12/19/03 that the Information Disclosure Statements filed on 8/23/01, 9/20/01, 12/6/01, and 4/17/02 had been entered and considered except the non-patent references (C1-C68) filed 8/23/01, which had not been considered due to the unavailability of the references caused by an error of the Office. However, these references would be considered if applicants provide copies of the references in response to this Office action without filing a separate IDS.

Applicant has not provided copies of those references, which have not been considered. An initialed copies of the form of PTO-1449 containing list of the references of the IDS filed 8/23/01 are hereby enclosed.

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***Claim Rejections-35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

It appears that the claimed invention does not fall into any of the categories of statutory subject matter: a process, machine, manufacture, and composition of matter. The preambles of the claims, e.g. that of claim 21, recite “A method for creating automated biological inferences comprising a computer readable medium having stored therein instructions for causing a process or to execute the steps, the steps comprising ....” The essence of the claims seems to be drawn to a “method ... comprising a computer readable medium having stored therein instructions for ....” If the claim is drawn to a process, it should comprises steps. In the instant claims, the “method” comprises computer readable medium, which is not a step. And if the claim is drawn to a product (e.g. a machine or manufacture) that comprises a computer readable medium, it should not be a method. Thus, the claims are nonstatutory because they are directed to neither a “process” nor a “product”, but rather embrace or overlap two different statutory classes of inventions. See MPEP, 2173.05(p)II.

Assuming *arguendo* that the “method” recited in the preambles indeed comprise the steps recited in the claims, the claimed method would still be nonstatutory for the following reason:

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The claims would be drawn to a method for creating automated biological inferences comprising constructing a connection network, applying calculations of likelihood statistics analysis and generating automatically one or more biological inferences.

The following analysis of facts of this particular patent application follows the rationale suggested in the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (OG Notices: 22 November 2005, available from the US PTO website at <http://www.uspto.gov/web/offices/com/sol/og/2005/week47/og200547.htm>).

The Guidelines states:

*To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways (Guidelines, p. 19):*

- The claimed invention "transforms" an article or physical object to a different state or thing.*
- The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.*

In the instant case, at least one embodiment of the claimed invention would merely manipulate data and perform a series of calculations by mathematical functions for determining inferences between molecules and biological processes. Thus, the process would not seem to transform an article or physical object to a different state or thing outside a computation device.

Furthermore, the invention would not produce a useful, concrete and tangible result. Specifically it would not produce a tangible result because the process would merely manipulates data and performs a series of calculations without using or making available for use the results of the manipulation to enable its functionality and usefulness to be realized.

### ***Claim Rejections-35 USC § 112***

The following is a quotation of the **second** paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-27 are rejected under 35 U.S.C. 112 , second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As set forth above in the rejection of the claims under 35 USC 101, the claims appear to be directed to neither a “process” nor a “product”, but rather embrace or overlap two different statutory classes of inventions. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph. See MPEP, 2173.05(p) II. In the instant case, the claims appear to be drawn to an apparatus comprising computer readable medium and use thereof to perform a series of steps.

Clarification of the metes and bounds of the claims is requested.

### ***Claim Objections***

Claim 22 is objected to as being dependent from a claim that is not a preceding claim thereto.

### ***Conclusion***

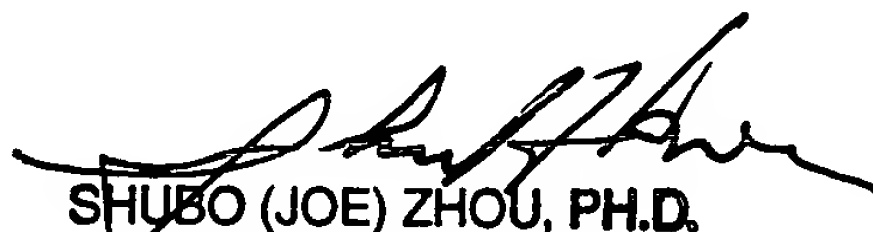
No claim is allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shubo (Joe) Zhou, whose telephone number is 571-272-0724. The examiner can normally be reached Monday-Friday from 8 A.M. to 4 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem (Remy) Yucel, Ph.D., can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

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SHUBO (JOE) ZHOU, PH.D.  
PATENT EXAMINER